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EXAMINER

HU, HENRY S

ART UNIT

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1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1. It is noted that Applicants' **Pre-Amendment** and **two IDS** (1 page each) are filed so far. This Application is a **371/PCT/JP04/13743**. Such pre-amendment is used to only eliminate improper multiple dependency. The examiner **accepts Applicants' one drawing sheet with Figures 1-2** filed on March 21, 2006 with this application (a brief description is on page 4). **Claims 1-5 with two independent claims** (Claims 1 and 5) are now pending. An action follows.

DETAILED ACTION

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner as well as by examining the references cited in international search report and IDS filed by Applicants.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following: It is noted that **two independent claims are marked with an underline**

I. **Claims 1-4**, drawn to **a perfluoroelastomer seal material**, wherein a rate of weight decrease is at most 1% by weight when the seal material is dried at 90°C for 5 hours,

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125°C for 5 hours and 200°C for 10 hours after immersing into perfluoro(tri-n-butyl) amine at 60°C for 70 hours and taking out the same.

II. **Claim 5**, drawn to a process of making a perfluoroelastomer seal material.

Such a process comprises a step of treating with a solvent having at least 50 % of a swelling rate based on said molded article, when said molded article is immersed at 60°C for 70 hours.

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, makes over the prior art. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

4. In view of Examiner’s own prior art search, European search report for Applicants’ priority document **PCT/JP2004/13743**, and the references or articles cited in two IDS’ filed so far by Applicants, **Claims 1-5** is either obvious or anticipated by following: **US 5,650,472 to Tatemoto et al.**, **US 7,309,743 B2 to Kawasaki et al.**, **EP 1,209,175 A1 to Saito et al.**, **US**

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5,565,512 to Saito et al., US 2002/0183457 A1 to Hintzer et al., and US 2003/0125463 A1 to Tatsu et al., each individually or in combination. In summary, these two groups have no common features in the preparation as well as its application since they are structurally different. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, the solvent-immersed/treated seal material for each group does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate.

5. With respect to the fact that “both groups are **structurally different** each other”, Group I is drawn to **a perfluoroelastomer-containing seal material**, while Group II is drawn to **a process of making a perfluoroelastomer-containing seal material**. Although the subject matter from each group may comprise the same or at least similar fluoroelastomer and/or solvent, its structure, function and application are indeed different. It is noted that Group I requires using perfluoro(tri-n-butyl) amine as immersing solvent, while Group II can use any solvent as long as it has at least 50 % of a swelling rate after the molded article is immersed for 60 °C for 70 hours. The seal’s performance is thereby at least somewhat different. Groups I and II are thereby not functionally equivalent and interchangeable.

6. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have

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acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that one phone call was made to **Abraham J. Rosner (registration # 33,276, tel: 202 293-7060)** on **August 13, 2008** to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

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10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796

/Henry S. Hu/
Examiner, Art Unit 1796

March 19, 2009